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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/680,994

10/08/2003

Kevin L. Parsons

87543

6645

24628

7590

07/31/2006

WELSH & KATZ, LTD
120 S RIVERSIDE PLAZA
22ND FLOOR
CHICAGO, IL 60606

EXAMINER

MAI, TRI M

ART UNIT

PAPER NUMBER

3727

DATE MAILED: 07/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/680,994	PARSONS, KEVIN L.	
	Examiner	Art Unit	
	Tri M. Mai	3727	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8-9 is/are allowed.
- 6) ☒ Claim(s) 1-7 and 10-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>02/23/04</u> | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

1. Claims 1-3, 11, 13, and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Scott (1174185). Scott teaches a device having a carrier having a C-shape recess, a latching mechanism, and a stop surface as claimed.

With respect to the scabbard being used for holding a baton the latching of the baton, it is submitted that this is an intended use. There is no structural difference between the holding apparatus in Scott and the claimed apparatus. With respect to the “over-center latching mechanism means”, the examiner submits said recitation does not impart any structure over the latching mechanism means as claimed. In the very least, object passes the center points of the latching mechanism 9 and this would meet the claimed limitation of “over-center latching mechanism means”. With respect to the snap-action, it is noted that the “snap” occurs when the object struck the stop surface, the examiner submits that the holder of Scott is capable of this intended functionality. The claims must be distinguished from the prior art in term of structure rather than function. In re Danly, 263 F.2d 844, 847(CCPA 1959). Furthermore, apparatus claims cover what a device is, not what a device does, Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F. 2d 1464, 1469 (CCPA 1935). See MPEP 2114.

Regarding claims 2 and 3, the apparatus having upper and lower frame portions 8' as claimed, and the latching mechanism being supported by and between the frame portions as claimed. Furthermore, it is noted that the term

2. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Scott in view of Nachtigal (1798028). It would have been obvious to one of ordinary skill in the art to provide a releasable friction pad 7 as taught by Nachtigal to protect the content.

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3. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over the Scott in view of Nachtigal rejection, and further in view of Byrd (3603550). It would have been obvious to one of ordinary skill in the art to make the friction member from rubber as taught by Byrd to provide the desired material for the friction pad.

4. Claims 1-3, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by McFerren et al. (5992811). McFerren teaches an apparatus having a C-shape opening, and a latching mechanism as claimed, a latching mechanism, and a stop surface as claimed.

With respect to the scabbard being used for holding a baton, it is an intended use. There is no structural difference between the holding apparatus in McFerren and the claimed apparatus. With respect to the “over-center latching mechanism means”, the examiner submits said recitation does not impart any structure over the latching mechanism means as claimed. With respect to the snap-action, it is noted that the “snap” occurs when the object struck the stop surface, the examiner submits that the holder of McFerren is capable of this intended functionality. The claims must be distinguished from the prior art in term of structure rather than function. In re Danly, 263 F.2d 844, 847(CCPA 1959). Furthermore, apparatus claims cover what a device is, not what a device does, Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F. 2d 1464, 1469 (CCPA 1935). See MPEP 2114.

Regarding claim 12, note that the bracket 12 is resilient, (col. 4, ln. 52-53).

5. Claims 4, 7, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over McFerren in view of Bacheldor (2379060). It would have been obvious to one of ordinary skill in the art to provide the pivoting configuration of Bacheldor in McFerren to insert the content easily.

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6. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over the McFerren rejection, as set forth above, and further in view of Ganny et al. (1666045), It would have been obvious to one of ordinary skill in the art to provide to provide the roller with crown as taught by Ganny to provide the desired shape of the wheels.

7. Claims 1-3, 11, and 14-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Schaefer (5699943). Schaefer teaches a holder having a C shaped recess and a having a stop surface, over center latching mechanism in Figs 4, 7. With respect to the snap action, it is noted that the “snap” occurs when the object struck the stop surface, the examiner submits that the holder of Schaefer is capable of this functionality.

Regarding claim 11, note the spring means in Fig. 4.

Regarding claim 16, note the wheel shaped carrier at 57.

Regarding claim 17, note the locking wheel 42 in the belt attachment means.

8. Claims 1-3, 11, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Hornung (1117491). Hornung teaches a C-shaped recess with rollers 9, and upper and lower housing portions 5, 6.

9. Claims 8 and 9 are allowed.

10. Applicant's arguments have been fully considered but they are not persuasive. Applicant asserts that none of the prior art teaches the C-shaped recess, and the snap. With respect to the C-shaped recess, it is noted of the recess of applicant's invention shown in Fig. 2 defined by portion 16. In compared with that of applicant's invention, it is submitted that the recesses in anyone of McFerren, Scott and Schaefer is as much as the shape as disclosed by applicant.

Furthermore, it is noted that a brief search on the Internet shows that “C-shpaed” can be broad as

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cited by the examples. With respect to the snap, as set forth above, it is noted that the “snap” occurs when the object struck the stop surface, the examiner submits that the holder of Scott is capable of this intended functionality. The claims must be distinguished from the prior art in term of structure rather than function. In re Danly, 263 F.2d 844, 847(CCPA 1959).

Furthermore, apparatus claims cover what a device is, not what a device does, Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F. 2d 1464, 1469 (CCPA 1935). See MPEP 2114. Furthermore, it is noted that the applicant’s specification disclosed that the “snap” is created by the spring mechanism. Thus, the springs in anyone of McFerren, Scott and Schaefer is capable of providing the “snap” as claimed. With respect to the “over-center latching mechanism means”, the examiner submits said recitation does not impart any structure over the latching mechanism means as claimed. In the very least, object passes the center points of the latching mechanism 9 in Scott and this would meet the claimed limitation of “over-center latching mechanism means”. Similar with that when an object passes the center points of the first roller in McFerren, and portion 104 in Schaefer.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tri M. Mai whose telephone number is (571)272-4541. The examiner can normally be reached on 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Newhouse can be reached on (571)272-4544. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tri M. Mai
Primary Examiner
Art Unit 3727

